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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/696,371

10/28/2003

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OIC0098US

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EXAMINER

DANNEMAN, PAUL

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/696,371	<b>Applicant(s)</b> KAHLON ET AL.	
	<b>Examiner</b> PAUL DANNEMAN	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 October 2009 has been entered.

***Response to Amendment***

2. Claims 1-9, 11 and 29 have been amended.
3. Claims 1-33 are pending in the application and have been examined.

***Response to Arguments***

4. The Examiner would like to thank the Applicant for catching the typographical error regarding Item 13 in the Final Office Action. Claims 4-8, 12-20 and 29-33 should have read Claims 4-8, 12-28 and 29-33.
5. Applicant has amended Claim 29. The Examiner, respectfully withdraws the Rejection of Claims 29-33 under 35 U.S.C. § 112.
6. Applicant's arguments with respect to independent claims 1, 9 and 29 and their dependent claims have been considered but are moot in view of the new ground(s) of rejection necessitated by the amendment of independent Claims 1, 9 and 29.

***Status of the Claims***

***Specification***

7. The amendment filed 29 October 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce

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new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: ***“synchronizing a source computerized inventory management system and a target computerized inventory management system, wherein said synchronizing is bidirectional, and ...”***

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. **Claims 1, 9 and 29** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant has amended the independent claims to read ***“synchronizing a source computerized inventory management system and a target computerized inventory management system, wherein said synchronizing is bidirectional...”*** the specification in paragraph [0005] only supports the synchronization of the inventory information and not the inventory management system. Appropriate correction is required.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. **Claims 1-8 are** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The

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Applicant has amended the independent claim to read ***“synchronizing a source computerized inventory management system and a target computerized inventory management system, wherein said synchronizing is bidirectional...”*** The Applicant in the method claim has unsuccessfully attempted to create a structure to link the method claim steps to a particular machine. The Examiner for purposes of this prosecution is interpreting the recitation to be ***“Software to perform the method of synchronizing source computerized inventory information and target computerized inventory information, wherein said synchronizing is bidirectional...”*** Appropriate correction is required.

12. **Claims 9 and 29** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant has amended the independent claims to read ***“synchronizing a source computerized inventory management system and a target computerized inventory management system, wherein said synchronizing is bidirectional...”*** It is unclear if the Applicant is synchronizing the Inventory Management System of the source and target, or whether only the stored data is being synchronized. The Examiner for purposes of this prosecution is interpreting the recitation to be ***“synchronizing a source computerized inventory information and a target computerized inventory information, wherein said synchronizing is bidirectional...”*** Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-8** are rejected under 35 U.S.C. § 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v.

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Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.* [http://lplaw.bna.com/lplw/5000/split\\_display.adp?](http://lplaw.bna.com/lplw/5000/split_display.adp?)

### ***Claim Rejections - 35 USC § 103***

14. **Claims 1-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchanan, US 5,758,355.

#### **Claims 1, 9 and 29:**

With regard to the limitations:

- ***Bidirectional synchronization of a source and target computerized inventory system.***
- ***Extracting inventory information in the 1<sup>st</sup> form.***
- ***Converting inventory information from the 1<sup>st</sup> form to the 2<sup>nd</sup> form.***
- ***Converting inventory information from the 2<sup>nd</sup> form into the Target form.***

Buchanan in at least Fig.1, Fig.2, Column 3, lines 29-52, Column 4, lines 18-38 discloses the bi-directional synchronization of a server and client database. Buchanan does not specifically disclose an inventory information system per se. However, in at least Column 4, lines 12-15

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discloses that the present invention is not intended to be limited to the embodiment shown. Buchanan in at least Column 2, lines 28-44 discloses a use of databases for such categories as company records and in Column 2, lines 45-60 and Column 7, lines 37-67 further discloses the use of databases for sales team records. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Buchanan's databases synchronization to include financial and inventory databases with the motivation to insure that all databases used by a company are properly synchronized.

**Claims 2-8, 10-28 and 30-33:**

With regard to the limitations:

- ***Extracting inventory information in the 1<sup>st</sup> form,***
- ***Converting inventory information from the 1<sup>st</sup> form to the 2<sup>nd</sup> form,***
- ***Converting inventory information from the 2<sup>nd</sup> form into the Target form, where***
- ***The inventory information is a collection of inventory records with various fields.***

Buchanan in at least Column 7, lines 1-32 discloses that the focal point of the present invention is the scanning of the server database to extract server database records to be transferred to the synchronizing client database where the database scans are done on a table by table basis in referential integrity order and applied in the same order on the other computer database. Buchanan does not specifically disclose an inventory information system per se. However, in at least Column 4, lines 12-15 discloses that the present invention is not intended to be limited to the embodiment shown. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Buchanan's databases synchronization to include financial and inventory databases with a plurality of inventory transaction elements with the motivation to insure that all parties are current regarding the financial and inventory status.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627



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14 December 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627